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Miller Thomson LLP
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20 Queen Street West
Toronto, ON M5H 3S1
CANADA

EXAMINER

CUMARASEGARAN, VERN

ART UNIT	PAPER NUMBER
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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,115	Applicant(s) JEANS, GABRIELLE	
	Examiner VERN CUMARASEGARAN	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each element of claim 1 begins with a capital letter. Since each claim is supposed to be one sentence, use of capital letters on the first letter of the first word of each element would be violating the rules of grammar.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-16, and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Pugliese et al (2002/0072974 A1).

As to claim 1, Pugliese et al. show signing up one or more sales agent users for access to a server application executed on a web server, the web server being connected to the internet

{paragraph 193 *where in order for the ShopLive system to have a sign-in process, shopper or merchant must have signed on the server application ("ShopLive")*.

Art Unit: 3629

Paragraph 130 inherently *shows the web server being connected to the internet because in order to provide "merchant webpages" the server has to be connected to the internet* }

customizing and publishing a web site promoting goods and services using the server application (paragraph 409), based on application of a plurality of web design selection tools to a plurality of web templates provided by the server application (paragraph 324 *where in order to customize content to shoppers, various design tools would be utilized*), whereby the web site includes a public area (paragraph 185) and an administration area (Fig.22).

collecting contact data (paragraphs 193 and 208 *where email addresses and mailing addresses of customers are collected in a database*) for customers and potential customers via the website, whereby the contact data is stored to a database linked to the server application, and whereby the server application enables the one or more sales agent users to control access to their contact data

{contact data is considered non-functional descriptive material because it is not functionally involved in the steps recited. The method steps would be performed the same regardless of the specific data that is collected. Thus contact data is not given patentable weight. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Paragraph 214 shows a gift registry where wish list data is collected and access to the wish list is controlled by the user};

creating customized sales tools (paragraph 362 *"loyalty programs"*) by means of a sales tool facility provided by the server application, whereby the sales tools are

customizable to promote sales based on a plurality of sales tool templates provided by the sales tool facility (paragraph 409);

communicating the sales tools to one or more selected customers or potential customers via the server application (paragraph 360).

As to claim 2, Pugliese et al show sending customized sales communications (“*gift registry*”) via the administration area, by operation of the sales tool facility, whereby the customized communications are based on a plurality of customizable communication templates provided by the server application, and customized by the one or more sales agent users (paragraph 214).

As to claim 3, Pugliese et al show one or more sales agent users initiating the creation of a client service report by operation of the sales tool facility, whereby the client service report lists a plurality of sales activities undertaken by one or more of the sales agent users in relation to one or more customers or potential customers selected by the one or more sales agent users (paragraph 139).

As to claim 4, Pugliese et al show the web templates and communication templates being updated by the operator of the web server to incorporate best practices for appealing to the target audience of the sales agent users' sales activities (paragraph 324).

As to claims 6 and 7, Pugliese et al show the server application and the database enabling the one or more sales agent users to create a customer or potential customer list (paragraph 216).

As to claim 8, Pugliese et al show one or more sales agent users entering calendar information to a calendar facility provided by the server application, such that customized sales communications are delivered by the web server based on the calendar information (paragraph 215).

As to claims 9 and 21, Pugliese et al show sales tool facility and calendar facility cooperating to provide the client service report that lists the activities of one or more of the sales agent users by reference to the calendar data entered to the calendar facility (paragraph 386).

As to claim 10, Pugliese et al show one or more sales agent users offering incentives to customers and potential customers to provide their contact data to the customized web site by operation of the customized web site (paragraphs 41-42).

As to claims 11 and 22, Pugliese et al show users sending customized e-cards using the e-card (electronic messages) facility included in the sales tool facility, whereby the e-card facility enables the one or more sales agent users to select between a plurality of e-card templates designed to appeal to the target audience of the one or more sales agent users' sales activities (paragraph 103).

As to claims 12 and 23, Pugliese et al show of promoting the customized web site on the Internet by initiating the server application to establish search engine positioning of the customized web site (paragraph 155).

As to claim 13, Pugliese et al show a server computer (paragraph 154 "*Shoplive servers*"), linked to the Internet (Fig.1, "*Shoplive Internet*"), and being further linked to a server application executable on the server computer (Fig.1, "*Shoplive Merchant*"), the

Art Unit: 3629

server computer being linked to a database (paragraph 13), the server application including:

- i) an administration facility that enables the operator of the server computer to manage access to the server application by a plurality of sales agent users (Fig.20);
- ii) a web publication facility that enables the plurality of sales agent users to customize and publish a customized web site (paragraph 409) promoting goods or services based on application of a plurality of web design selection tools to a plurality of web templates (paragraph 324 *where in order to customize content to shoppers, various design tools would be utilized*), the customized web site enabling the collection of contact data of customers and potential customers (paragraphs 193 and 208 *where email addresses and mailing addresses of customers are collected in a database*);
- iii) a database management facility linked to the database (paragraph 13), the database management facility enabling the management of the contact data on the database (paragraph 193), wherein the database management facility enables the plurality of sales agent users to restrict access to their contact data to only other users selected by each of the plurality of sales agent users

{contact data is considered non-functional descriptive material because it is not functionally involved in the steps recited. The method steps would be performed the same regardless of the specific data that is collected. Thus contact data is not given patentable weight. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Paragraph 214 shows a gift registry where wish list data is collected and access to the wish list is controlled by the user};

Art Unit: 3629

iv) a sales tool facility that enables the plurality of sales agent users to create customized sales tools, wherein the sales tools are customizable to promote sales based on a plurality of sales tool templates provided by the sales tool facility (paragraph 362 “*loyalty programs*”); and

v) a communication facility, including an email facility, that enables the plurality of sales agent users to send email communications to third parties including the customers and potential customers, wherein the email communications include customized sales tools (paragraph 360).

As to claim 14, Pugliese et al show sales tool facility and email facility cooperating to enable the plurality of sales agent users to send customized sales communications whereby customized communications are based on a plurality of customizable communication templates provided by the sales tool facility (paragraph 219).

As to claim 15, Pugliese et al show sales tool facility enabling the plurality of sales agent users to create a client service report that lists a plurality of sales activities undertaken by one or more of the plurality of sales agent users in relation to one or more customers or potential customers selected by the one or more of the plurality of sales agent users (paragraph 139).

As to claim 16, Pugliese et al show that web templates and communication templates are updated by the operator of the server computer to incorporate best practices for appealing to the target audience of the plurality of sales agent users' sales activities (paragraph 324).

As to claim 17, Pugliese et al show web publication facility enabling the plurality of sales agent users to design web sites dynamically by selecting a plurality of design features corresponding to a particular web site design, and then previewing the web site design by means of a preview feature provided by the web publication facility.

As to claim 18, Pugliese et al show database management utility enabling the plurality of sales agent users to create a customer list (paragraph 216).

As to claim 19, Pugliese et al show plurality of sales agent users building the customer list by entering data into a form provided by the server application (paragraph 216).

As to claim 20, Pugliese et al show the server application further including a calendar facility that enables the plurality of sales agent users to add calendar data, and the calendar facility, sales tool facility and email facility cooperate such that customized sales communications are delivered by the server computer based on the calendar information (paragraph 215).

As to claims 24 and 25, Pugliese et al show the database management facility enables one or more of the plurality of sales agent users to share their contact data with one or more other selected sales agent users

{contact data is considered non-functional descriptive material because it is not functionally involved in the steps recited. The method steps would be performed the same regardless of the specific data that is collected. Thus contact data is not given patentable weight. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.

Cir. 1983). Paragraph 214 shows a gift registry where wish list data is collected and shared with others}.

As to claims 26 and 27 Pugliese et al show an administration facility that enables the operator of the server computer to manage access to the server application (“Login”) by a plurality of sales agent users (Fig. 20);

a web publication facility that enables the plurality of sales agent users to customize and publish a customized web site promoting goods or services based on application of a plurality of web design selection tools to a plurality of web templates (paragraph 324 *where in order to customize content to shoppers, various design tools would be utilized*), the customized web site enabling the collection of contact data of customers and potential customers (paragraphs 193 and 208 *where email addresses and mailing addresses of customers are collected in a database*);

a database management facility linked to the database (paragraph 13), the database management facility enabling the management of the contact data on the database (paragraph 13), wherein the database management facility enables the plurality of sales agent users to restrict access to their contact data to only other users authorized by the one or more of the plurality of sales agent users;

{contact data is considered non-functional descriptive material because it is not functionally involved in the steps recited. The method steps would be performed the same regardless of the specific data that is collected. Thus contact data is not given patentable weight. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Paragraph 214 shows a gift registry where wish list data is collected and

Art Unit: 3629

access to the wish list is controlled by the user};

a sales tool facility that enables the plurality of sales agent users to create customized sales tools, wherein the sales tools are customizable to promote sales based on a plurality of sales tool templates provided by the sales tool facility (paragraph 362 “loyalty programs”); and

a communication facility, including an email facility, that enables the plurality of sales agent users to send email communications to third parties including the customers and potential customers, wherein the email-communications include customized sales tools (paragraph 360).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pugliese et al. in view of official notice.

Pugliese et al show the server application enabling the one or more sales agent users to design web sites dynamically by selecting in the administration area a plurality of design features corresponding to a particular web site design. However, Pugliese et al do not expressly show previewing the website design by means of a preview feature accessible via the administration area. It is notoriously

old and well known in the art at the time of the invention to allow the preview of a website design before it is published on the website. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pugliese et al and allow the preview of website design.

Response to Arguments

Applicant's arguments filed May 21, 2008 have been fully considered but they are not persuasive. Applicant argues that the contact information is not non-functional descriptive material and that the applicant "...can point to a functional relationship between this element and the method of generating sales of the invention..." Yet no such functional relationship is recited in the claims. The contact data can be considered functional descriptive material if it is utilized to generate sales over the internet. Merely controlling access to the contact data does not render the contact data functional. Examiner concludes that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability. The USPTO need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Examiner respectfully maintains the rejection.

With regard specification objection, the examiner accepts the amended abstract and the objection is withdrawn.

With regard to the 35 U.S.C. 112 second paragraph rejection of claims 13, 26 and 27, the rejection is withdrawn since the amended claims have overcome the rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERN CUMARASEGARAN whose telephone number is (571)270-3273. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vc

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629